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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/614,790	07/12/2000	Sharon F. Kleyne	HME/7982.001	2570
29085	7590	07/25/2006	EXAMINER	
HOWARD EISENBERG, ESQ. 2206 APPLEWOOD COURT PERKASIE, PA 18944			WANG, SHENGJUN	
			ART UNIT	PAPER NUMBER

1617

DATE MAILED: 07/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/614,790
Filing Date: July 12, 2000
Appellant(s): KLEYNE, SHARON F.

Howard M. Eisenberg
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed April 10, 2006 appealing from the Office action mailed November 30, 2005.

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(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

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The following is a listing of the evidence (e.g., patents, publications, Official Notice, and admitted prior art) relied upon in the rejection of claims under appeal.

US Patent 5,893,515	Hahn et al.	April 13, 1999
US Patent 5,620,633	Junkel et al.	April 15, 1997
US Patent 5,588,564	Hutson et al.	December 31, 1996
WO 97/23177	Embleton et al.	July 3, 1997

(9) Grounds of Rejection

Claim Rejections 35 U.S.C. 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 90-93, and 97-101 are rejected under 35 U.S.C. 103(a) as being unpatentable over Junkel et al. (US 5,620,633), in view of Hahn et al. (US 5,893,515, IDS), Hutson et al. (US 5,588,564, IDS), in further view of Embleton (of record).

Junkel et al. teaches a potable misting device for sunbathers and others involved in athletic pursuits, which provide a cooling current air with atomized liquid mist, such as water, to combat the elements of heat and dehydration attendant with athletic activities and/or prolonged exposure to the sun. Junkel et al. further disclosed that such type of devices is well-known in the art. See, particularly, the abstract, and column 1, lines 18-63. The device comprises a sealed

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container, water within the container, and an actuator for spraying a mist of water from the container, See, particularly, the drawing, and columns 4, line 60 bridging to column 5, line 10.

Junkel et al. do not teach expressly to apply the mist to the face of a subject, or the subject is suffering from dry eye.

However, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to direct the fan-mist device to the face, and apply the mist accordingly and enjoy the relief of the dryness, including the dry eye condition, caused by heat and dehydration. Further, it would have been obvious to any one who experienced dry condition, and suffering dry eye to apply a mist to moisturizing the eye and relieve the dryness, particularly, in view the fact that device for producing water mist is common and is with access of normal person. See, e.g., Hahn et al. and Hutson et al. It is a basic instinct for human to use water for relieve of dryness. Any form of water, including mist would have been obvious to a person experiencing dryness. As to claim 92, which recites the particular condition of protein and electrolytes, it is noted the mist generated by the device of Junkel is not likely to wash away those protein and electrolyte since the water is in the form of mist, not a stream. Further, the employment of pressurizing agent in a mist generating device instead of hand generated pressure as disclosed by Junkel et al. is seen to be an obvious variation and is within the skill of artisan. Further, Embleton teaches that liquid administered to the eyes should be not more than 30 μ l, over administering of liquid to eyes provide no benefit. (see page 1, lines 5-23). Therefore, one would not try to over flow the eye with excess of water. Further, note the size of droplets in mist is in the range of 2 to 100 micrometers. See "Selected terms in colloid and interface science Aerosols." (of record). Note as to the "dry eye," recited in the claims,

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absent specific definition in the claims or in the specification, the term is given a broad interpretation. As to the limitation “and wherein the water is sprayed on the surface of eye within a period of 10 seconds (or 5 seconds),” note it would have been obvious to moisturize the eyes with just one or two bolus of the mist as that should have been sufficient to relieve the dryness, particularly, in view of Embleton’s teaching that liquid administered to the eyes should be not more than 30 μ l, over administering of liquid to eyes provide no benefit. Regarding claims 98-101, it is noted that the claims read on applying a mist toward the face by a device like those disclosed by Junkel, in a short period of time, such as 5 or 10 seconds for controlling the volume (see pages 4-5 of the specification). Since it is known that over flow the eye with excess of water provide no benefit, one would have avoid such overflow by just one or two bolus of the mist.

(10) Response to Argument

3. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Considering the cited references as a whole, the claimed invention, spraying a mist toward the eyes of a subject suffering dry eyes, would have been obvious to one of ordinary skill in the art. Note, the references Hahn et al. and Hutson et al. are cited in the rejections to show that the fact that device for producing water mist is common and is with access of a normal person. Embleton reference is cited for teaching that liquid administered to the eyes should be not more than 30 μ l, over administering of liquid to eyes provide no benefit. The claimed subject matter would have been obvious to one of ordinary skill in the art, considering the totality of the cited references.

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4. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the teaching suggestion and motivation are found both in the cited references and in the knowledge generally available to one of ordinary skill in the art. Particularly, moisturizing a dry body part for relieving the dryness is within the knowledge generally available to one of ordinary skill in the art. Therefore, the examine respectfully submits that a prima facie case of obviousness has been established.

The secondary evidences presented in the application have been fully considered, but are found insufficient to rebut the prima facie case of obviousness. The declarations under 37 CFR 1.132 on the record are insufficient to overcome the obvious rejections based upon Junkel et al as set forth above because: the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). It is well settled patent law that mode of action elucidation does not impart patentable moment to otherwise old and obvious subject matter. Applicant's attention is directed to *In re Swinehart*, (169 USPQ 226 at 229) where the Court of Customs and Patent Appeals stated "is elementary that the mere recitation of a newly discovered function or property, inherently possessed by thing in the prior art, does not cause a claim drawn

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to those things to distinguish over the prior art.” In the instant invention, the claims are directed to the ultimate utility set forth in the prior art, albeit distanced by various functions. The ultimate utility for the claimed compound (water) is old and well known rendering the claimed subject matter obvious to the skilled artisan. It would follow therefore that the instant claims are properly rejected under 35 USC 103.

Appellants further argued that the objective evidences presented in the declaration should have been sufficient to rebut the prima facie case of obviousness. The arguments are not convincing. As discussed above, moisturizing eye with plain water is obvious as it arise from a common sense. Appellants’ discovery that this old, or otherwise obvious practice, is better than a commercial method, i.e., artificial tear, is by no mean to be sufficient to make this method patentable. It is deemed improper to exclude others from practice this old, and/or otherwise obvious method.

Appellants also assert commercial success as objective evidence of none obviousness. To establish objective evidence of nonobvious base on commercial success, a few notable principles are well settled. An applicant who is asserting commercial success to support its contention of nonobviousness bears the burden of proof of establishing a nexus between the claimed invention and evidence of commercial success. The Federal Circuit has acknowledged that applicant bears the burden of establishing nexus, stating:

In the ex parte process of examining a patent application, however, the PTO lacks the means or resources to gather evidence, which supports or refutes the applicant's assertion that the sale constitutes commercial success. C.f. Ex parte Remark, 15 USPQ2d 1498, 1503 (Bd. Pat. App. & Int. 1990)(evidentiary routine of shifting burdens in civil proceedings inappropriate in ex

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parte prosecution proceedings because examiner has no available means for adducing evidence).

Consequently, the PTO must rely upon the applicant to provide hard evidence of commercial success.

Further, objective evidence of nonobviousness including commercial success must be commensurate in scope with the claims. In re Tiffin, 448 F.2d 791, 171 USPQ 294 (CCPA 1971). It is noted that the appealed claims are directed to method of moisturizing dry eyes. The alleged evidence of commercial success is about a device for providing mist. Therefore, the nexus between the alleged success and the claimed invention has not been established,

Objective evidence which must be factually supported by an appropriate affidavit or declaration to be of probative value includes evidence of unexpected results, commercial success, solution of a long-felt need, inoperability of the prior art, invention before the date of the reference, and allegations that the author(s) of the prior art derived the disclosed subject matter from the applicant. See MPEP 716.01 to 716.03. In the instant case, appellants merely shows that the, appellants' discovery that this old, or otherwise obvious practice, i.e., moisturizing eye with water, is better than a commercial method, i.e., artificial tear, is by no mean to be sufficient to make this method patentable. It is deemed improper to exclude others from practice this old, and/or otherwise obvious method.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

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